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EXAMINER

SANTIAGO CORDERO, MARIVELISSE

ART UNIT

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2617

NOTIFICATION DATE

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CONTINUATION SHEET

Continuation of 3:

The amendment to the specification is still objected to under 35 U.S.C 132(a) because it introduces new matter into the disclosure. Applicant argues that there is no reason for the objection to remain, given that the specification was amended to its previous form (Remarks: page 5, last paragraph). In response, the Examiner notes that the previous form was also objected to under 35 U.S.C 132(a) because it introduced new matter into the disclosure. See page 2 of Office Action mailed on 5/27/2009. Furthermore, regarding the drawings, Applicant argues that Figure 3C is not prior art (Remarks: page 6, under "Drawing Objection"). In response, the Examiner respectfully disagrees. Applicant's original specification (page 7), under the "Brief Description of the Drawings" section, clearly stipulates that "Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO system during a conventional suspend time", thus, considered an admission or prior art. Consequently, Figure 3C should be labeled with --Prior Art-- because only that which is old is illustrated and the objection to the drawings is maintained, i.e., Fig. 3C should be labeled with --Prior Art-- because only that which is old is illustrated.

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Applicant's arguments regarding claims 3, 4, 7, and 8 have been fully considered but they are not persuasive.

Applicant argues that Fig. 3C is not prior art, that the specification makes it clear that Fig. 3C is not prior art, and that the description simply does not support the Action's assertion that Fig. 3C is prior art; importantly, because the reference to "a conventional suspend time" in the

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brief description stating that Figs. 3A-3C illustrate one and only one conventional suspend time (i.e., is singular not plural) and those of ordinary skill in the art would understand, are Figs. 3A and 3B, and that, at best, the brief description cited by the office, by itself, is ambiguous as to whether Fig. 3C is "a convention suspend time" (Remarks: pages 6-9). In response, the Examiner respectfully disagrees. Applicant's original specification (page 7), under the "Brief Description of the Drawings" section, clearly stipulates that "Figs. **3A to 3C** are timing charts showing processing performed in the 1xEVDO system **during a conventional suspend time**". Contrary to being ambiguous, the specification explicitly states it. In addition, other portions of the original specification further support the Examiner's position. For example, page 13, lines 12-13, and page 14, line 11 through page 15, line 1, where it states that Figs. 3A to 3C show timing charts of communications using the suspend time in the 1xEVDO system and Fig. 3C is a timing chart of a case where a suspend time is not set. Furthermore, Applicant's arguments referring to a portion of the specification contradicts the argument that Fig. 3C is not prior art and further supports the Examiner's position that Fig. 3C is prior art. That is, in page 10, last paragraph of the Remarks, Applicant argues that the specification makes clear that not setting the suspend time was understood by those in the art to deteriorate data communication and thus was to be avoided. This statement raises the following question: if not setting the suspend time was not prior art, as Applicant intends to argue, then how come not setting the suspend time was understood by those in the art to deteriorate data communication? This is clearly contradictory to Applicant's argument that Fig. 3C is not prior art and is therefore, an admission that not setting the suspend time (as in Fig. 3C) is prior art, because the specification makes it clear that

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not setting the suspend time was understood by those in the art to deteriorate data communication.

Applicant argues that even assuming *arguendo* that Fig. 3 of Applicant's specification constitutes prior art, the prior art of instant case teaches away from the proposed combination, because the Office's stated motivation of "conserving battery power" would not have motivated one of ordinary skill in light of the understanding of those skilled in the art that "when the suspend time is not set, a throughput of data communication is deteriorated when the state of radio wave is not good" (Remarks: pages 9-11). In response, the Examiner respectfully disagrees. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). The statement that "a throughput of data communication is deteriorated" is specific to the condition that the radio wave is not good. There is no indication in the specification that a throughput of data communication is deteriorated in all conditions, including when the radio wave is good. Although not setting the suspend time would deteriorate communication when the state of the radio wave is not good, as applicant intends to argue, it nevertheless provides the advantage of immediately shifting to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings." *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). The fact that Applicant does not set the

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suspend time for a different purpose (to not impact the communication performance) does not alter the conclusion that not setting it would be *prima facie* obvious from the purpose disclosed in the references (to immediately shift to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power). Therefore, as stated in the last Office Action, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to, after the second changing section changes the monitoring timing of the first communication method of AAPA Figure 4, not set the suspend time as suggested by AAPA's Figure 3C for the advantages of performing any conventional processing performed in the 1xEVDO system (see page 7, lines 16-18 of original specification) and immediately shifting to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power. Applicant argues that the claimed invention produces unexpected and fruitful results contrary to the prior art's teaching (Remarks: page 11). In response, a showing of unexpected results must be based on evidence, not argument or speculation. *In re Mayne*, 104 F.3d 1339, 1343-44, 41 USPQ2d 1451, 1455-56 (Fed. Cir. 1997).

/MARIVELISSE SANTIAGO-CORDERO/

Examiner, Art Unit 2617